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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/752,263	01/05/2004	William R. Rassman	M-15239-IP US	4042
32605	7590	06/16/2006	EXAMINER	
MACPHERSON KWOK CHEN & HEID LLP 1762 TECHNOLOGY DRIVE, SUITE 226 SAN JOSE, CA 95110			NGUYEN, VI X	
			ART UNIT	PAPER NUMBER
			3734	

DATE MAILED: 06/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/752,263	RASSMAN ET AL.	
	Examiner	Art Unit	
	Victor X. Nguyen	3734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 and 25-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-24 and 30-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The request filed on 5/31/2006 for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 10/752,263 is acceptable and a RCE has been established. An action on the RCE follows.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 41 and 42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In claim 41, the disclosure corresponding to elected species 10 of figures 11a-d does not describe an actuator for applying a force to a **fat sack** for expelling **the fat sack** through the open distal end in response to the force as recited. As claim 42, the disclosure corresponding to elected species 10 of figures 11a-d does not describe an actuator controllably operable to provide pressure in the hair graft chamber for drawing a **fat sack** into the hair graft chamber as recited.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 13-24 and 30-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Rassman (5,817,120).

Rassman discloses in figures 2a-f, an apparatus for transplanting a hair graft having the limitations as recited in the above listed claims, including: a housing (22) that includes an actuator chamber (21) and a hair graft chamber (26) for housing a loaded hair graft (34), a vacuum source (see col. 11, lines 60-67 and col. 12, lines 8-11)) coupled to the housing to provide suction thereby drawing a hair graft into the hair graft chamber, where a rod (31) is inside the housing, and where an actuator (26) moves the end of the rod substantially so that a loaded hair graft is delivered to a scalp wound (32), where the vacuum source coupled to the actuator chamber, and where the end of the rod is capable of moving between a first position and a second position in order to deliver the hair graft to a scalp wound, and where the actuator includes a plunger (26) connected to the rod, and where the plunger is able to move the rod, where the actuator includes a piston (29) inside the actuator chamber, and where the device further includes a spring (27) coupled to the piston, where the spring is capable of moving the end of the rod to the first position from the second position., and where the device further comprises a projection (41) which connected to the hair graft chamber, the projection extends in parallel to the central axis and beyond the open distal end of the housing.

Response to Arguments

4. Applicant's arguments filed 5/4/2006 and 5/31/2006 have been considered but they are not persuasive. In response to applicant's argument that Rassman reference does not disclose a vacuum source for drawing a hair graft into a hair graft chamber and a rod is inside the housing. As claims 13 and 30 are currently written, it can be interpreted broadly that the Rassman at least

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disclose in figures in 2a, 2c, a housing 22 includes an actuator chamber 21, a hair graft chamber 26 for housing a loaded hair graft 34, a vacuum source (see col. 11, lines 60-67 and col. 12, lines 8-11 coupled to the housing, and where a rod 31 is inside the housing. Regarding the intended use of a vacuum source for drawing a hair graft into a hair graft chamber, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the instant case, the vacuum source of Rassman would have been capable of performing the use as claimed. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X. Nguyen whose telephone number is (571) 272-4699. The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on (571) 272-4697. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Victor X Nguyen
Examiner
Art Unit 3734



Vn
6/10/2006



MICHAEL J. HAYES
SUPERVISORY PATENT EXAMINER